

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF
THE TTAB

Mailed: 5/25/04

Hearing:
February 19, 2004

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Ientry, Inc.

Serial No. 76323231

Todd Stockwell of Stockwell & Associates for Ientry, Inc.

Idi Aisha Clarke, Trademark Examining Attorney, Law Office
105 (Thomas G. Howell, Managing Attorney).

Before Seeherman, Hohein and Hairston, Administrative
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Ientry, Inc. has appealed from the final refusal of
the Trademark Examining Attorney to register WEBPRONEWS as
a mark for services identified, as amended, as "computer
services, namely, providing a collection of accessible news
stories in the field of technology, business, and computers

on a world wide computer network."¹ Registration has been refused pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark so resembles the following registered marks,² all owned by the same entity, that, when used in connection with applicant's identified services, it is likely to cause confusion or mistake or to deceive:

WEB PRO for books, magazines,
catalogues, manuals, brochures,
pamphlets, guides and newsletters in
the field of on-line information
services;³

WEB.PRO for newsletters in the field of
information technology;⁴ and

PRO NEWS for section of magazine
dealing with computers and video games.⁵

¹ Application Serial No. 76323231, filed October 9, 2001, asserting first use and first use in commerce on March 8, 2000.

² The Examining Attorney had previously cited another registration, for WEBNEWS, owned by a third party. The Examining Attorney withdrew the refusal based on this registration after her consideration of applicant's request for reconsideration. Although applicant acknowledged the withdrawal of this citation in its recital in its brief of the prosecution history of the application, applicant continued to discuss the registration in its analysis of the likelihood of confusion duPont factors.

³ Registration No. 2162335, issued June 2, 1998. The registrant filed a partial Section 8 and 15 affidavit on June 30, 2003, after the registration was cited as a bar to the registration of applicant's mark, and the affidavit was accepted and acknowledged. As a result of this filing, the Class 42 services (providing on-line magazines and newsletters in the field of on-line information services) which were part of the original registration have been deleted.

⁴ Registration No. 2434447, issued March 13, 2001.

⁵ Registration No. 2060583, issued May 13, 1997; Section 8 and 15 affidavit accepted and acknowledged.

The appeal has been fully briefed, and applicant and the Examining Attorney appeared at an oral hearing before the Board.⁶

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also, *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

The goods identified in the cited registrations are closely related to the computer services identified in

⁶ In its brief applicant asserts that it is the owner of a registration for another mark, WEBPRO. That registration was not properly made of record during the prosecution of the application (it appears that only the mark and registration number were submitted as part of a listing of what were characterized as third-party marks). The Examining Attorney's objection to our consideration of that registration is well taken. See Trademark Rule 2.142(d). Even if we had considered the registration, it would not have affected our decision herein. See *In re Nett Designs Inc.*, 236 F3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001).

applicant's application. The subject matter of the publications in the WEB PRO registration--the field of on-line information services--falls within the subject matter of the news stories--the field of technology and computers--provided by applicant. That is, the news stories provided through applicant's services would include stories about on-line information services. Similarly, the subject matter of the newsletters which are identified in the WEB.PRO registration--information technology--is encompassed by the "technology" news stores which applicant provides through its service. As for the PRO NEWS registration, again, the "section of magazine dealing with computers and video games" is encompassed within the computer news stories which are provided through applicant's service.

Obviously the media through which these stories are provided are different. Registrant provides information in print media--books, magazines, catalogues, manuals, brochures, pamphlets, guides and newsletters, while applicant makes news stories available through a computer network. However, it is not necessary that goods or services be identical in order to support a finding of likelihood of confusion. In fact, it is not even necessary that they be similar or competitive, or even that they move

in the same channels of trade. It is sufficient if the goods or services are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods and/or services are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same producer. See *In re International Telephone & Telegraph Corp.*, 197 USPQ 910 (TTAB 1978).

It is common knowledge that books, magazines, catalogues and the like are frequently made available in both printed form and on-line. At one time, the registrant itself offered both the currently identified printed matter and "providing on-line magazines and newsletters in the field of on-line information services."⁷ The NEXIS database, which the Patent and Trademark Office often uses to make articles of record, is an on-line version of newspaper articles that have appeared in printed form. And applicant, during the prosecution of this application, has submitted definitions taken from an on-line dictionary, rather than a dictionary in book form. In view of the

⁷ As noted previously, the services were deleted from registrant's registration at the time it filed its Section 8 affidavit.

widespread practice of disseminating information in both printed and on-line form, consumers are likely to assume that news stories which are made available on a computer network, and stories, magazines, magazine sections and the like in printed form, emanate from or are sponsored by the same source if they were sold under confusingly similar marks. The question is not whether consumers can distinguish between the goods and services, and recognize that in one case the goods are in printed form, and in another case the information is on-line. Rather, the question is whether consumers are likely to confuse the source of the goods and services.

Applicant has acknowledged that the consumers of both applicant's services and registrant's goods are the same, brief, p. 6, and that they are offered in "similar channels of trade." Brief, p. 7. Thus, although the form of the media in which the information is offered is different, we find that the goods and services are related.

The registered mark WEB PRO and applicant's mark WEBPRONEWS are very similar. Applicant has essentially taken registrant's mark and added the descriptive term NEWS to it. Although applicant has eliminated the spaces between the words in its mark, the individual words remain evident, and are reinforced by the way the mark would be

pronounced. Therefore, the mark would be understood as WEB PRO NEWS. Consumers who are familiar with WEB PRO would assume that WEBPRONEWS is merely a variant of the WEB PRO mark, with registrant having added the word NEWS perhaps because the mark is used in connection with news stories.

As for the cited mark WEB.PRO, this mark does include a dot between the elements WEB and PRO. However, the dot may not be noted by consumers, in which case the analysis with respect to WEBPRONEWS and WEB PRO is the same. To the extent that consumers do note the dot, because of the goods with which the mark is used, they will see it as a reference to the subject matter of registrant's goods, information technology, in that a dot is used in this manner in web addresses. Thus, the dot reinforces the meaning of the WEB portion of the mark. Again, consumers who are familiar with the registrant's mark WEB.PRO are likely to view WEBPRONEWS as a variant of registrant's mark. This is particularly true if they are aware of registrant's WEB PRO mark as well; they will assume that registrant has several marks which are variations on a theme.

The cited mark PRO NEWS is different from the registrant's other marks, but again, there is a similarity between this mark and applicant's mark WEBPRONEWS. The

term "web," as discussed herein, is descriptive of applicant's services, which are offered "on a world wide computer network," i.e., the web. The addition of this descriptive term to the cited mark is not sufficient to distinguish the marks.

Applicant has asserted that the registrant's marks are weak. In support of this position, applicant points to a submission made with its request for reconsideration consisting of listings from the Patent and Trademark Office's TESS database, which state that 7563 records of "WEB" marks and 14493 records of PRO marks were found. The exhibit lists 50 each of such records, but it shows only the mark, serial number and/or registration number, and an indication as to whether the application/registration is live or dead. There is no indication as to the goods or services. Further, of the 50 listings for WEB marks, only four are for registrations, while none of the listings for PRO marks is for registrations; the others reference pending applications. Although third-party registrations may be used in the manner of dictionary definitions, see *The Conde Nast Publications, Inc. v. Miss Quality, Inc.*, 507 F.2d 1404, 184 USPQ 422 (CCPA 1975), third-party applications have no such value.

However, the evidentiary failings with regard to third-party registrations is not critical to this proceeding, since such registrations are not necessary to show the meaning of WEB and PRO. Applicant has submitted dictionary definitions of these words, as well as of NEWS:⁸

Web: 9: *capitalized*: WORLD WIDE WEB

World Wide Web: a part of the Internet designed to allow easier navigation of the network through the use of graphical user interfaces and hypertext links between different address-called also *Web*

Pro: professional

Professional (adj): 1a: of, relating to, or characteristic of a profession; b: engaged in one of the learned professions; c: (1) characterized by or conforming to the technical or ethical standards of a profession.

News: 2a: material reported in a newspaper or news periodical or on a newscast; b: matter that is newsworthy.

We also take judicial notice of the following definitions of "professional":⁹

(adj.) 4. Having great skill or experience in a particular field of activity

(n.) 1. A person following a profession. 3. One who has an assured

⁸ Merriam-Webster (Online) Dictionary, 2002. <http://Merriam-webster.com>.

⁹ The American Heritage Dictionary of the English Language, © 1970.

competence in a particular field or occupation.

Based on these definitions, we agree that the cited marks WEB PRO and WEB.PRO are suggestive of goods that would be of interest to professionals who deal with the Internet or World Wide Web. However, applicant's mark WEBPRONEWS has the same connotation, indicating that applicant's services involve news that would be of interest to these same professionals. PRO NEWS, as used on the goods, also suggests that registrant's goods provide news that is of interest to professionals in the computer field. Although the scope of protection accorded to suggestive marks may be more limited than that accorded to arbitrary marks, that protection still extends, as here, to prevent the use by others of very similar marks for related goods and services.¹⁰

Applicant also asserts that the consumers of its services and the registrant's goods are sophisticated and discriminating, and specifically that consumers are sophisticated business and computer users in the technology

¹⁰ Applicant has also submitted what it characterizes as "Internet Search Results for the terms 'WEB' and 'PRO' and NEWS'." It is not clear from where applicant obtained these listings. Because we cannot rely on the authenticity of the information provided in the listings which consist primarily of domain registration information, we find them to be of no probative value. Certainly they are not sufficient to show the existence of any WEBPRO marks, or that the public is familiar with them.

field. Even if we accept that this is the case, discriminating consumers are not immune from confusion. *Wincharger Corp. v. Rinco, Inc.*, 297 F.2d 261, 132 USPQ 289 (CCPA 1962). Because of the similarity of the marks and the goods/services, sophisticated computer users are still likely to assume that the goods and services are sponsored by or emanate from the same entity.

With respect to the factor of actual confusion, applicant states that it has not experienced any instances of confusion, nor has it come to its attention that the registrant has. However, applicant has used its mark for a relatively limited amount of time (since March 2000); evidence of actual confusion is notoriously difficult to obtain; and we have no information about the extent of the use or advertising of applicant's services or of the registrant's goods. In view thereof, we have no basis on which to conclude that there has been an opportunity for confusion to occur if it were likely to occur. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000). Accordingly, we cannot find that this factor favors applicant.

Finally, it is well established that, to the extent that any doubt exists on the issue of likelihood of confusion, it must be resolved in favor of the registrant

Ser No. 76323231

and prior user. In re Pneumatiques, Caoutchouc Manufacture et Plastiques Kleber-Colombes, 487 F.2d 918, 179 USPQ 729 (CCPA 1973).

For the foregoing reasons, we find that applicant's mark, as used in connection with its identified services, is likely to cause confusion with the three cited registered marks.

Decision: The refusals of registration are affirmed.